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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,919

10/04/2004

Alain Badore

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03/14/2008

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EXAMINER

RAHMANI, NILOOFAR

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

03/14/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/509,919	Applicant(s) BADORC ET AL.	
	Examiner NILOOFAR RAHMANI	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 13 and 14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/8/08 and 10/04/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-5, and 13-14 are pending. Claims 6-12, and 15-30 are cancelled.

2. ***Priority***

This application is filed on 10/04/2004, which is a 371 of PCT/FR03/01030, filed on 04/02/2003, which claims the priority of FRANCE 0204220, filed on 04/04/2002.

3. The rejection of claims 13-14 under 35 U.S.C. 112, second paragraph is withdrawn in view of the applicant's amendment on paper dated on 01/08/2008.

4. The rejection of claims 1-2 under 35 U.S.C. 102(a) over Bora et al. is withdrawn in view of the applicant's amendment and argument on paper dated on 01/08/2008.

5. The rejection of claims 1-2 under 35 U.S.C. 102(b) over Kakehi et al. is withdrawn in view of the applicant's amendment and argument on paper dated on 01/08/2008.

6. The rejection of claims 1-5, and 13-14 under Obvious-type double patenting over US 2006/0199962 is maintained for reason of record. Applicants will address this rejection, and the issue of Terminal Disclaimer, when this obviousness-type double patenting rejection is the sole remaining issue. It is examiner's position that a timely filed terminal Disclaimer can overcome this rejection.

7. The rejection of claims 1-2 under 102(b) over Wei et al. is maintained for reason of record. Applicants argue that RN 25627-81-0, 3-benzoyl-1-indolizinecarbonitrile, wherein R₁ being cyano and RN 25627-86-5, 3-benzoyl-1-indolizinecarboxamide, wherein R₁ being CONH₂ are not encompassed by the instant claims. It is examiner's position that applicant's argument for these two compounds is persuasive. However, the rejection for the compounds RN 17281-79-7, 3-benzoyl-1-indolizinecarboxylic acid, methyl ester and RN 154224-59-6, 3-benzoyl-2-methyl-1-indolizinecarboxylic acid, methyl ester are maintained. Because these two compounds are encompassed by the instant claimed compounds. Therefore, the rejection is maintained.

8. *New Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, and 13-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the proviso at the end of the claim 1 on paper dated

01/08/2008. Therefore, the proviso is new matter. This is a NEW MATTER rejection. Removal of all new matter is required, In re Russmussen 210 USPQ 325.

If the proviso is removed, then the following rejections are maintained.

9. The rejection of claims 1-2 under 102(b) over Tamura et al. is maintained for reason of record. Applicants acknowledge the compound VI of Tamura et al. was encompassed by the claims 1 and 2 if the present application, as previously presented. However, as presently amended, claims 1 and 2 are not anticipated by compound VI of Tamura. It is examiner's position that the proviso in the presently amended claims 1 and 2 are new matter. Therefore the rejection is maintained.

10. The rejection of claims 1-2 under 102(b) over Overzet et al. is maintained for reason of record. Applicants acknowledge that this 1-hydroxy compound of Overzet et al. was encompassed by the claims 1 and 2 if the present application, as previously presented. However, as presently amended, claims 1 and 2 are not anticipated by compound VI of Tamura. It is examiner's position that the proviso in the presently amended claims 1 and 2 are new matter. Therefore the rejection is maintained.

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public

PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NILOOFAR RAHMANI

D.MARGARET SEAMAN

02/21/2008

PRIMARY EXAMINER

GROUP 1625

/D. Margaret Seaman/

Primary Examiner, Art Unit 1625